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10/029,200	12/28/2001	Hee Woong Lee	108256-00014	5394

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EXAMINER

IP, SIKYIN

ART UNIT	PAPER NUMBER
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1742

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/029,200	Applicant(s) LEE ET AL.	
	Examiner Sikyln Ip	Art Unit 1742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 12-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-11 are, drawn to an alloy, classified in class 420, subclass 34+.
- II. Claim 12 is, drawn to an electrical resistance wire, classified in class 148, subclass 325+.
- III. Claims 13-14 are, drawn to a method of producing a resistance wire, classified in class 148, subclass 595+.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II-III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions they have different modes of operation, different functions, or different effects such as catalytic converter for automotive exhaust gas (see abstract of JP 04350148, reference of record).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Groups II and/or III, restriction for examination purposes as indicated is proper.

Originally presented claims 1-5 , Group I, was elected by original presentation of claims. A complete action in paper dated June 26, 2003 has been sent to the applicants on the merits of such claims.

New claims 12 and 13-14 are ,(Groups II and III, respectively), as now presented in paper dated December 29, 2003 is/are directed to new claimed invention which is classified in new search class/subclass as set forth above. These claims are clearly directed to a separate and distinct invention from that of the original presented claims which recite features in a different statutory class of subject matter from the newly presented claims. The search for originally presented claims is not required to search of newly presented claims.

Therefore, as shown by the separate and distinct classifications above of the Group I and Groups II-III claims, as respectively claimed; the different fields of search; and in accordance with 37 C.F.R. §1.145, applicants are required to restrict the claims presented in this case to the invention previously elected. Thus, the newly submitted Groups II-III, claims 12-14, are held withdrawn from further consideration by the Examiner by the prior election, 37 C.F.R. §1.142 (b), M.P.E.P. 818.01, 818.02(a) and 821.03.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 11 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which

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was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The limitation "electric resistance of more than 46 Ohm" in new claim 11 has no literal support in the specification as originally filed. The expression "more than" includes those electric resistance not disclosed in Table 1.

Claim Rejections - 35 USC § 103

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-5 and 7-9 are rejected under 35 U.S.C. § 103 as being unpatentable over USP 6296953 to Linden et al (col. 2, lines 20-35), JP 05098401 (abstract [57]), JP 06330246 (abstract [57]), JP 09263906 (abstract [57]), JP 49115927 (abstract), JP

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04083820 (abstract), JP 04350148 (abstract), JP 02118053 (abstract), CN 1122841 (abstract), SE 513989 (abstract), or SE 508595 (abstract).

The cited reference(s) disclose(s) the features including the claimed Fe-Cr-Al alloy compositions. When prior art compounds essentially "bracketing" the claimed compounds in structural similarity are all known, one of ordinary skill in the art would clearly be motivated to make those claimed compounds in searching for new products in the expectation that compounds similar in structure will have similar properties. In re Gyurik, 596 F.2d 1012, 1018, 201 USPQ 552, 557 (CCPA 1979); See In re May, 574 F.2d 1082, 1094, 197 USPQ 601, 611 (CCPA 1978) and In re Hoch, 57 CCPA 1292, 1296, 428 F.2d 1341, 1344, 166 USPQ 406, 409 (1970). Therefore, it would have been obvious to one of ordinary skill in the art to select any portion of range, including the claimed range, from the broader range disclosed in a prior art reference because the prior art reference finds that the prior art composition in the entire disclosed range has a suitable utility. Also see MPEP § 2131.03 and § 2123.

With respect to Be content, cited references do not disclose the claimed Be element. However, the claimed Be element content reads on zero which suggests said element could be eliminated from instant claims.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 02118053CN 1122841, SE 513989, or JP 49115927 as applied to claims above, and further in view of case law.

The cited references disclose the features such as Fe alloy composition and its application as electrical heating coil wire (for example, see JP 49115927, abstract) substantially as claimed as set forth in the rejection above except for the electric resistance. However, the electric resistance is material property and the instant alloy

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composition are overlapped by the cited references; consequently, the electric resistance property as recited in the instant claim would have inherently possessed by the teachings of the cited references. Therefore, the burden is on the applicant to prove that the product of the prior art does not necessarily or inherently possess characteristics attributed to the claimed product. In re Spade, 911 F.2d 705, 708, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990) and In re Best, 195 USPQ, 430 and MPEP § 2112.01.

“Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established, In re Best, 195 USPQ 430, 433 (CCPA 1977). ‘When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.’ In re Spada, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Therefore, the prima facie case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. In re Best, 195 USPQ 430, 433 (CCPA 1977).”

Claims 1-6, and 10 are rejected under 35 U.S.C. § 103 as being unpatentable over GB 1299390 (GB ‘390).

GB ‘390 in page 2 disclose(s) the features including the claimed Fe alloy composition including Be. Said reference discloses total amount of Ti and Be is from 0 to 4 wt.%. In Tables 2 and 3, said reference discloses tensile strength anticipated the claimed tensile strength. When prior art compounds essentially "bracketing" the claimed compounds in structural similarity are all known, one of ordinary skill in the art would clearly be motivated to make those claimed compounds in searching for new products in the expectation that compounds similar in structure will have similar

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properties. In re Gyurik, 596 F.2d 1012, 1018, 201 USPQ 552, 557 (CCPA 1979); See In re May, 574 F.2d 1082, 1094, 197 USPQ 601, 611 (CCPA 1978) and In re Hoch, 57 CCPA 1292, 1296, 428 F.2d 1341, 1344, 166 USPQ 406, 409 (1970). Therefore, it would have been obvious to one of ordinary skill in the art to select any portion of range, including the claimed range, from the broader range disclosed in a prior art reference because the prior art reference finds that the prior art composition in the entire disclosed range has a suitable utility. Also see MPEP § 2131.03 and § 2123. With respect to the instant claimed Al, Zr, and/or REM elements that their contents include zero, which suggests said elements are optional elements and could be eliminated from the claimed composition.

Response to Arguments

Applicant's arguments and declaration filed December 29, 2003 have been fully considered but they are not persuasive.

Applicants' declaration is noted. But, unexpected results have not been shown by the Tables in declaration/specification because which fail to compare the claimed subject matter with the closest prior art. In re Burckel, 201 USPQ 67, In re Baxter Travenol Labs., 952 F.2d 388, 392, 21 USPQ2d 1281, 1285 (Fed. Cir. 1991), and In re De Blauwe, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984). Comparison must be done under identical condition except for the novel features of the invention. In re Brown, 173 USPQ 685 and In re Chapman, 148 USPQ 711. **The showing of unexpected results must be occurred over the entire claimed range.** In re Clemens, 622 F.2d 1029, 206 USPQ 289, 296 (CCPA 1980). **The scope of the**

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showing must be commensurate with the scope of the claims. In re Tiffin, 448 F.2d 791, 792 (Fed. Cir. 1971), In re Coleman, 205 USPQ 1172, In re Grasselli, 713 F.2d 731, 743, 218 USPQ 769, 778 (Fed. Cir. 1983), and In re Greenfield, 197 USPQ 227. Moreover, instant claims except claim 6 do not require Be as essential element. Furthermore, GB 1299390 has taught Be in their Fe alloy (page 2).

Applicants argue that Be is positively recited in instant claim 1. But, the lower limit of Be includes zero.

Applicants' argument in page 7 of the instant remarks is noted. First, Be and misch metals have not been positively recited in instant claim 1 with a minimum lower limits. Second, GB 1299390 has taught Be in Fe alloy, which has composition overlapped the instant claims 1-6 and 10.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The above rejection relies on the reference(s) for all the teachings expressed in the text(s) of the references and/or one of ordinary skill in the metallurgical art would have reasonably understood or implied from the text(s) of the reference(s). To emphasize certain aspect(s) of the prior art, only specific portion(s) of the text(s) have been pointed out. Each reference as a whole should be reviewed in responding to the rejection, since other sections of the same reference and/or various combination of the cited references may be relied on in future rejection(s) in view of amendment(s).

All recited limitations in the instant claims have been met by the rejections as set forth above.

Applicant is reminded that when amendment and/or revision is required, applicant should therefore specifically point out the support for any amendments made to the disclosure. See 37 C.F.R. § 1.121.

Examiner Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Ip whose telephone number is (571) 272-1241. The examiner can normally be reached on Monday to Friday from 5:30 A.M. to 2:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Roy V. King, can be reached on (571)-272-1244.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


SIKYIN IP
PRIMARY EXAMINER
ART UNIT 1742

S. Ip
April 5, 2004